



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,239	07/01/2003	Eric Kuo	018563-006700US	3324

46718 7590 10/04/2006

TOWNSEND AND TOWNSEND AND CREW, LLP (018563)  
TWO EMBARCADERO CENTER, EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER
----------

WILSON, JOHN J

ART UNIT	PAPER NUMBER
----------	--------------

3732

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,239

Applicant(s)

KUO, ERIC

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 14-16, 19-21 and 27-48 is/are pending in the application.
- 4a) Of the above claim(s) 44-47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 37 is/are allowed.
- 6) ☒ Claim(s) 1, 14-16, 19-21, 27-36, 38-43 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/25/06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restriction***

This application contains claims directed to the following patentably distinct species: Species 1 including packaged appliances or appliances having different size to indicate order of use, see claims 1, 14-16, 19-21, 27-43 and 48. Species 2 including appliances marked with a color dissolvable dye or color removable wrapper to indicate order of use. The species are independent or distinct because Species 1 does not require a dye or removable wrapper as claimed in Species 2.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Newly submitted claims 44-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: See above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Braverman (3780856). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the packages in a continuous chain with a non-numeric indicia at the end. Braverman teaches providing packages in a continuous chain 10 in the order of use, and shows non-numeric indicia at an end package, Fig. 1, see "after meal". It would be obvious to one of ordinary skill in the art to modify Chishti to include indicating order by providing packages in a continuous chain and non-numeric indicia as shown by Braverman in order to make use of known ways of solving the problem of providing packages and indicating the order of use. All of the structure being shown, the specific meaning of the indicia at the end, is merely a matter of mental interpretation, and/or, intended use, and as such, is properly not given patentable weight. Further, in view of the teaching of Chishti, indicating the first appliance to be used would be obvious to one of ordinary skill in the art.

Claims 19-21 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klein (4038753). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the appliances on a framework with non-numeric indicia. Klein teaches packaging dental appliances 18 by providing them on a framework 16 and using non-numeric indicia, "REG" see Fig. 1. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing packages on a framework and non-numeric indicia as shown by Klein in order to make use of known ways of solving the problem of providing dental appliances. Chishti teaches indicating the order of use. To supply the appliances in the order of use on the frame would have been obvious to one of ordinary skill in the art to make it easy for a user to follow the desired order. All of the structure being shown, the specific meaning of the indicia, is merely a matter of mental interpretation, and/or, intended use, and as such, is properly not given patentable weight. As to claim 48, the above combination shows arranging on a framework, all of the structure being shown, the meaning of the arrangement is merely a mental step, and/or, intended use of the shown structure, and as such, is not given patentable weight. Further Chishti teaches ordering by use.

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klatt (2003/0136698). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the appliances in a package in order of use. Klatt teaches providing items in a

package 1 in the order of use, [0006]. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing items in a package in their order of use as shown by Klatt in order to make use of known ways of solving the problem of providing package articles and indicating the order of use.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Baggett (4811845). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia on the packages. Baggett teaches marking packages with non-numeric indicia. It would be obvious to one of ordinary skill in the art to modify Chishti to include using non-numeric indicia as shown by Baggett in order to make use of known types of indicia for communicating information on order.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Seidl (DE 3925088). Chishti teaches providing packages and indicating their order of use with numbers, column 15, lines 1-5. Chishti does not show providing additional marks on the numbers. Seidl teaches providing additional marks 4, Fig. 2, on numbers. It would be obvious to one of ordinary skill in the art to modify Chishti to include using indicia that includes numbers with additional marks as shown by Seidl in order to make use of known forms of indicia to communicate information.

Claims 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Fuller. Chishti teaches providing packages and indicating their order of use with numbers, column 15, lines 1-5. Chishti does not show removed numbers. Fuller teaches using removed numbers 6, Fig. 2, as indicia. It would be obvious to one of ordinary skill in the art to modify Chishti to include using removed numbers as shown by Fuller in order to make use of known indicia for communicating desired information.

Claims 30 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Morrish et al (4726970). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show using shaped indicia. Morrish teaches using shaped indicia 35, Fig. 4, on packages 14. It would be obvious to one of ordinary skill in the art to modify Chishti to include the use of shaped indicia as shown by Morrish in order to make use of known indicia for communicating desired information.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Rohlcke et al (5326259). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to use non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the

Art Unit: 3732

art to modify Chishti to include the type of indicia shown by Wong in order to make use of known indicia to best communicate the desired order. The above combination does not show using a cutout notch. Rohlcke teaches that a notch may be used as an alternative indicia, column 1, lines 21-24. It would be obvious to one of ordinary skill in the art to modify the above combination to include a notch as shown by Rohlcke in order to make use of known alternative indicia.

Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Martin (6884071). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to use non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the art to modify Chishti to include the type of indicia shown by Wong in order to make use of known indicia to best communicate the desired order. The above combination does not show using a bar code as indicia. Martin teaches that a bar code may be used as an alternative indicia, column 7, lines 24-27. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bar code as shown by Martin in order to make use of known alternative indicia.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Martin (6884071) as



Art Unit: 3732

applied to claim 40 above, and further in view of Morris et al (5923001). The above combination does not show using a radio frequency tag. Morris shows using radio frequency tags to identify items. It would be obvious to one of ordinary skill in the art to modify the above combination to include a radio frequency tag as shown by Morris in order to make use of known ways of using and reading indicia to best communicate the desired message.

***Allowable Subject Matter***

Claims 1 and 37 are allowed.

***Information Disclosure Statement***

The IDS filed May 25, 2006 has been considered and an initialed copy attached.

***Response to Arguments***

Applicant's arguments filed August 10, 2006 have been fully considered but they are not persuasive. Wong is used to show using a non-numeric indicia an dental appliances to indicate use of that appliance, and as known in the art, their use is progressive. With respect to Wong and all of the applied combinations, all the structure being shown, the specific meaning of indicia is merely a mental step, and/or, intended use step. Further, Chishti teaches ordering. Using known indicia for indicating the meaning or intended use that is taught by Chishti is obvious in the shown use of indicia.

***Conclusion***

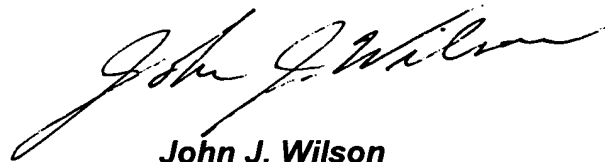
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
September 28, 2006